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| APPLICATION NO.                                                          | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/838,045                                                               | 04/18/2001  | Donald J. Mischo     | MISCHO-1            | 2957             |
| 20606                                                                    | 7590        | 06/28/2005           | EXAMINER            |                  |
| KEITH FRANTZ<br>401 WEST STATE STREET<br>SUITE 200<br>ROCKFORD, IL 61101 |             |                      | RODRIGUEZ, JOSEPH C |                  |
|                                                                          |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                          |             |                      | 3653                |                  |

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                        |                                          |  |
|------------------------------|----------------------------------------|------------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/838,045   | <b>Applicant(s)</b><br>MISCHO, DONALD J. |  |
|                              | <b>Examiner</b><br>Joseph C. Rodriguez | <b>Art Unit</b><br>3653                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-47 is/are pending in the application.
- 4a) Of the above claim(s) 10-23 and 42-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-28, 30-41 and 45-47 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

***Final Rejection***

Applicant's arguments filed 2/22/05 have been fully considered but they are not persuasive for reasons detailed below.

The prior art rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-28, 32-41 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Omann (US 5,451,003).

Regarding claims 24, 32-38, 45, Omann teaches shredding the waste shingles to a specific size (col. 4, ln. 44-61; col. 6, ln. 27-36) and then separating said materials with a screen (68, 132; col. 6, ln. 58-63), wherein the material penetrating the screen can be regarded as fines with an asphalt-aggregate composition as the shredded waste shingles contain an aggregate layer (i.e., rock) (col. 1, ln. 36-48) and the materials not penetrating the screen can be regarded as the coarse material. Here, Applicant teaches that an asphalt-aggregate ratio can be established by setting a shredder size or a screen opening size (spec., para. 44-47), thus Omann can be interpreted as establishing and controlling an asphalt-aggregate ratio when teaching a shredder or a screen set to a specific size. Further, Omann teaches processing the waste shingles for

use in roadways (Abstract), thus the roadways material requirements can be regarded as establishing the "target asphalt-aggregate ratio" and this ratio can be regarded as established "independently" of the shingle ratio.

Regarding claims 25-28, 39-41, Omann teaches checking the ratio (i.e., gradation testing) of the material being processed and then adjusting the fine ratio (i.e., choosing appropriate screen size) (col. 6, ln. 35-63). Further, the shredding devices (38, 138) can be regarded as separation stations, wherein the addition of material, such as aggregate, with an optional third conveyor (col. 6, ln. 48-56) or the changing of the screen aperture size can be regarded as adjusting said separation rate.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendenhall (US 4,095,284) in view of Omann (US 5,451,003).

Mendenhall teaches that it is known to crush and then separate asphalt-aggregate compositions into various size ranges, thus it is implicit from the use of a crusher and the selection of a size range that an asphalt-aggregate ratio has been established and then controlled (col. 1, ln. 10-29).

Mendenhall thus teaches all that is claimed except for expressly teaching this method applied to scrap asphalt shingles having an aggregate layer. Omann, however, teaches that it is known to process scrap asphalt shingles having an aggregate layer (col. 1, ln. 35-47; col. 4, ln. 44 et seq.). Moreover, Omann teaches that these types of asphalt shingles can be recycled for various uses and that a need still exists for processing these shingles to the cut size claimed by Applicant (col. 1, ln. 63-col. 2, ln. 22). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Mendenhall in view of Omann.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Omann (US 5,451,003) in view of Brock (US 5,201,472), Suzuki (JP 55142502 A) and what is well known in the art.

Omann teaches all that is claimed except for expressly teaching a specific ratio by weight and by volume. The mere choice of a ratio by weight or by volume, however, is well known in the art and Examiner takes Official Notice of such. Here, it is noted that aggregate ratios are known to relate to the material strength of certain substances (Suzuki, English Abstract), thus the mere selection of the ratio can not be regarded as novel when this ratio is a mere design choice related to the common variable of desired material strength. Further, Brock teaches that it is known to set and monitor the aggregate ratio by weight for better handling (col. 5, ln. 30-col. 6, ln. 48). Therefore, it

would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Omann as taught above.

Further, it is here noted that Applicant failed to properly traverse this finding, thus this feature can be regarded as admitted prior art.

Claims 24-28, 32-41 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Omann (US 5,451,003) in view of Minge et al. ("Minge")(US 2,368,371).

Omann as set forth above teaches all that is claimed except for expressly teaching forwarding the fine and material separately for further processing. Minge, however, teaches a method of processing waste shingle material where the coarse and fine materials are forwarded separately for further processing (Figure; p. 2, ln. 18- p. 3, ln. 25). Moreover, Minge teaches that coarse material may be recovered at the various stages of separation as the different types of coarse material have different uses throughout industry (Id.). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Omann by separately processing the coarse material at the various separation stages as taught by Minge as these different types of coarse material may prove more valuable than the ultimately produced fines material.

***Response to Arguments***

Applicant's arguments that the prior art fails to teach the claimed features are unpersuasive. In particular, Applicant's focus on the "separating" step is misplaced. Omann clearly teaches a screen that separates the shingle material based on a size determination. It is irrelevant that the larger sized material also eventually pass through the screen after being comminuted as the claim limitation has still anticipated. Moreover, the Minge reference renders this argument moot as this reference clearly teaches the added claim limitations that possess Applicant's interpretation of the "separating" step. Consequently, the claims stand rejected.

Applicant's focus on the "establishing" and "controlling" step is also misplaced. Omann clearly teaches a screen that separates the shingle material based on a size determination. Here, Applicant is respectfully reminded that claims are given their broadest reasonable interpretation during examination. Further, Applicant's own specification teaches that, inter alia, the screen size and the rate of flow, aid in "establishing" and "controlling" the target ratio, thus it is unclear why Applicant is now arguing that Examiner should not use these teachings as guidance in interpreting the claim limitations. Moreover, the prior art makes abundantly clear that the size of the screen openings is a major factor in determining the target ratio, thus it is unclear why the selection of the screen sizes during the device design and use is not regarded as "establishing" and "controlling" the target ratio. Consequently, as a reasonable interpretation of the claims is anticipated by the prior art, the claims stand rejected.

***Allowable Subject Matter***

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Election/Restrictions***

This application contains claims 10-23 and 42-44 drawn to an invention nonelected without traverse of June 25, 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

**<http://pair-direct.uspto.gov>**

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

Art Unit: 3653


Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **571-272-6584**. Further, the supervisor's contact information is Donald Walsh, 571-272-6944.

Signed by Examiner Joseph Rodriguez

jcr

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June 22, 2005



DONALD F. WALSH  
SUPERVISORY PATENT EXAMINER  
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